

REMARKS / ARGUMENTS

A. GENERALLY

Reconsideration of this application is hereby requested. Claims 12-14, 18-20, 22, and 58-66 are currently pending in the application. Claims 15, 17, 24-25, 34-36, 38, 47, and 50 have been canceled by the present amendment. Claims 58-66 have been amended to claim the non-excitatory pulse as a first phase of a bi-phasic pacing pulse, as found in previously presented claims 12-14 and 18. The dependency of claim 22 was amended to correct 112 antecedent basis issues. No New matter has been added.

Claim Rejections – 35 USC 102

Claims 12-14, 18, 19, 22, and 59

Claims 12-14, 18, 19, 22, and 59 were rejected under 35 USC 102 as being anticipated by Freeman. To anticipate a claim, the reference must teach every element of the claim:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In the present case, Freeman fails to disclose at least the non-excitatory pulse being a first phase of a bi-phasic pacing pulse. The Office action states that "the background pulses of Freeman can be bi-phasic, and are non-excitatory." However, the claim requires the non-excitatory pulse to be *a first phase* of a bi-phasic *pacing pulse*, which is not taught or fairly suggested in Freeman. Indeed, the non-excitatory bi-phasic pulses 90 in figure 2 of Freeman are applied constantly to reduce skeletal activation without regard to any phase of cardiac contraction and are clearly not part of pacing pulses 80.

Claims 61-63

Claims 61-63 were rejected under 35 USC 102 as being anticipated by Scherlag. However, Scherlag at least fails to disclose the non-excitatory pulse being a first phase of a bi-phasic pacing pulse, as presently claimed.

Claim Rejections – 35 USC 102

Claims 61-63

Claims 61-63 were rejected under 35 USC 103 as being obvious over Scherlag. However, even if it were obvious to provide pacing to Scherlag, Scherlag still fails to disclose or fairly suggest the non-excitatory pulse being a first phase of a bi-phasic pacing pulse, as presently claimed.

Claims 58-60 and 64-66

Claims 58-60 and 64-66 were rejected under 35 USC 103 as being obvious over Scherlag in view of Nichols. However, even if it were obvious to provide the pressure sensor of Nichols and pacing of Scherlag, Scherlag and Nichols still fail to disclose or fairly suggest the non-excitatory pulse being a first phase of a bi-phasic pacing pulse, as presently claimed.

For the above reasons, Applicant respectfully submits that claims 12-14, 18-20, 22, and 58-66 are allowable over the cited prior art and requests reconsideration and allowance of the claims.

B. INTERFERENCE

Applicant herein submits another Supplemental Request for Interference pursuant to 37 CFR 41.202. The Supplemental Request for Interference reflects updates to the prior request to address issues raised by the examiner in the Office Action dated August 6, 2007 and to address the amendment of the claims.

The Office Action dated August 6, 2007 asserted that: "As counts must be patentably distinct, it is not clear how the same claims define two patentably distinct inventions. Both the chart and write up appear to be in error." (Office Action, pp. 2-3.) Applicant respectfully disagrees with this assertion. According to the MPEP 2301.03 (8th Ed; Rev. 4):

When an interference is declared, there is a description of the interfering subject matter, which is called a "count." Claim correspondence identifies claims that would no longer be allowable or patentable to a party if it loses the priority determination for the count. To determine whether a claim corresponds to a count, the subject matter of the count is assumed to be prior art to the party. If the count would have anticipated or supported an obviousness determination against the claim, then the claim corresponds to the count. 37 CFR 41.207(b)(2). Every count must have at least one corresponding claim for each

party, but it is possible for a claim to correspond to more than one count. (Emphasis added by underlining.)

Further, 37 CFR 41.202(a)(2) requires an applicant seeking to provoke an interference to propose “one or more counts and show how the claims correspond to one or more counts.” While counts are directed to patentably distinct subject matter, counts themselves do not have to be patentable. Applicant respectfully submits that neither the rules nor the MPEP precludes a claim from corresponding to more than one proposed count.

C. CONCLUSION

For the above reasons, Applicant respectfully requests reconsideration of the stated rejections and submits that it is appropriate for the Examiner to declare an interference between the present application and U.S. Patent 6,233,484, U.S. Patent, 6,330,476, and U.S. Patent 6,317,631.

Should any further questions arise concerning this application or in the event that the above amendments do not place the application in condition for allowance, Applicant respectfully requests a telephone interview. Attorney for the Applicant may be reached at the number listed below.

Respectfully Submitted,

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